

REMARKS

The Office Action mailed February 2, 2007 has been carefully considered. Within the Office Action Claims 46-55, 85, 87, 88, 94, 95, 97, 98, 104, 106 and 107 have been rejected. The Applicants have amended Claims 46, 55, 94. The Applicants reserve the right to rejoin the withdrawn claims upon allowance of the base claims upon which they are dependent. Applicants have also cancelled Claim 51 and reserve the right to pursue Claim 51 in a divisional or continuation application. Reconsideration is respectfully requested. A one month extension accompanies this reply.

Rejection under U.S.C. § 103**Ozaka**

Claims 46, 48-55, 94-95, 97-98, 104, 106-107 and 113 were rejected under 35 U.S.C. § 103(a) as being allegedly obvious over Japanese patent 09-026850 to Ozaka (hereinafter “Ozaka”) The Applicants respectfully traverse.

In determining obviousness four factual inquiries must be looked into in regards to determining obviousness. These are determining the scope and content of the prior art; ascertaining the differences between the prior art and the claims in issue; resolving the level of ordinary skill in the pertinent art; and evaluating evidence of secondary consideration. Graham v. John Deere, 383 U.S. 1 (1966); KSR Int’l Co. v. Teleflex, Inc., No 04-1350 (U.S. Apr. 30, 2007) (“ Often, it will be necessary . . . to look into related teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion

claimed by the patent at issue. To facilitate review, this analysis **should be made explicit.**”) (emphasis added).

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fed. Cir. 1983). Thus, when considering the whole prior art reference its entirety, portions that would lead away from the claimed invention must be considered. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983), See M.P.E.P. 2141.02. Thus, it is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731 (Fed. Cir. 1983).

Claims 46 and 94 recite, among other things, an actuator configured to output a haptic effect, the actuator having an eccentric mass rotatable about a shaft and configured to rotate the eccentric mass about the shaft upon being activated. Claims 46 and 94 also recite an actuator sensor coupled to the actuator and configured to measure the amount of rotation of the eccentric mass when the actuator is activated, wherein the actuator controls the amount of rotation of the eccentric mass in response to the measured amount of rotation to output an inertial haptic effect pulse to the housing.

Ozaka does not teach an actuator and actuator sensor as recited in Claims 46 and 94. All that is apparently disclosed in Ozaka is an eccentric mass which rotates when activated. (Ozaka, Paragraphs 80-89). In addition, the eccentric mass is used in the scenarios described in relation to Figures 1-3 in which vibration is output by the actuator instead of braking being applied to the movement of the mouse while an icon or object is dragged. (Ozaka, Paragraph 87). In particular, Figures 1-3 (paragraphs 29-31) in Ozaka disclose that a reaction force is applied

which makes the actuation “heavier” than usual. Considering that Ozaka describes this in the context of moving the pointer while its in the boundaries of the icon, Ozaka is describing a texture feeling, such as damping or braking in which the actuation feels heavier. This is further supported in paragraph 32 where this type of reaction force is applied when dragging objects 33. One skilled in the art reading Ozaka would find no apparent reason to use an actuator to produce an inertial haptic effect pulse, because Ozaka explicitly uses damping and texture, as well as pure vibration, to add the haptic effect only during dragging of an object. In addition, one skilled in the art reading Ozaka would not find any apparent reason to use an actuator sensor to control movement of the eccentric mass in the actuator, because Ozaka does not stand for the proposition of producing haptic effect pulses As stated, Ozaka only applies braking or vibration, not pulses when dragging or crossing a boundary of an icon. Accordingly, the subject matter in Claims 46 and 94 is non-obvious over Ozaka and is therefore patentable. Accordingly, Claims 46 and 94 are allowable over Ozaka.

Claim 104 recites, among other things, an actuator coupled to the moveable portion of the housing, the actuator having an eccentric mass and configured to actuate the eccentric mass to output an inertial haptic force to the moveable portion in response to an actuating signal from the computer device. In addition, Claim 113 recites, among other things, means for producing an inertial haptic force to the moveable portion, the means for producing having an eccentric mass rotated about a shaft in response to an actuating signal from the computer device. Ozaka does not teach any component which produces an inertial haptic force to a moveable portion of the housing nor does it provide one skilled in the art any apparent reason to modify the device in Ozaka to apply haptic effects to the moveable portion. All that is mentioned in Ozaka regarding moveable portions is that the user is able to push the mouse button to penetrate through a boundary of an object when the boundary is signaled to the user as a vibration . For at least these

reasons, one skilled in the art would not find the motivation to modify Ozaka to reach the subject matter recited in Claims 104 and 113. Therefore, Claims 104 and 113 are allowable over Ozaka.

Claims 47-55, 85, 87 and 88 are dependent on Independent Claim 46; Claims 95, 97 and 98 are dependent on Independent Claim 94; and Claims 106 and 107 are dependent on Independent Claim 104. For at least the reasons stated above, Claims 46, 94 and 104 are allowable over Ozaka. Accordingly, Claims 47-55, 85, 87, 88, 95, 97, 98, 106 and 107 are allowable for being dependent on allowable base claims.

In Applicants' prior reply, Applicants had requested whether the Office Action was taking official notice under M.P.E.P. 2144.03 that the actuator taught in Ozaka is a DC motor and it is obvious to be able to rotate the motor in two directions to output an inertial haptic effect in light of rejection to Claim 55. The Applicants assume that the Office Action has intended to take official notice of these facts under M.P.E.P. 2144.03 that the rationale supporting the obviousness rejection is based on common knowledge in the art or "well-known" prior art. Under M.P.E.P. 2144.03, "[i]f the applicant traverses such an assertion the examiner should cite a reference in support of his or her position." Applicant traversed this assertion and requested that a reference be cited in support of the position outlined in the Office Action in regards to dependent Claim 55. However, no such support or official notice was indicated in the present Office Action. Accordingly, Applicants respectfully request that the rejection to Claim 55 be withdrawn, and Claim 55 be allowed.

Ozaka in view of Aarts

Claim 47 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Ozaka in view of U.S. Patent No. 6,411,280 to Aarts (hereinafter "Aarts"). This rejection is respectfully traversed. Claim 47 is dependent on Independent Claim 46. For at least the reasons

stated above, Claim 46 is allowable over Ozaka. Accordingly, Claim 47 is allowable over Ozaka and Aarts, individually or in combination, for being dependent on allowable base claim.

Holmdahl in view of Ozaka

Claims 104 and 113 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,452,586 to Holmdahl et al. (“Holmdahl”) in view of Ozaka. This rejection is respectfully traversed.

The office action contends that Holmdahl is prior art over Claims 104 and 113 of the present application. Holmdahl has a filing date of November 30, 1998, whereas the present application is a CIP of U.S. Patent 6,353,427, whereby 6,353,427 is a continuation of application No. 09/103,281, now U.S. Patent 6,088,019 (the ‘019 patent) filed June 23, 1998. In the ‘019 patent, it is disclosed in an embodiment that the actuator is coupled to the moveable portion and can be a rotary actuator which outputs a rotational force. (‘019 Patent. Col. 14, Lines 51-53). Considering that the subject matter recited in Claims 104 and 113 is disclosed and supported in the ‘019 patent, Claims 104 and 113 both receive an effective filing date of June 23, 1998 which predates the Holmdahl reference. Accordingly, Holmdahl is not prior art to the recited subject matter in Claims 104 and 113 and cannot be used as prior art to support an obviousness rejection. For at least these reasons, Claims 104 and 113 are allowable over the cited references.

Conclusion

It is believed that this reply places the above-identified patent application into condition for allowance. Early favorable consideration of this reply is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698. A one month extension accompanies this reply.

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Respectfully submitted,



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